



Paper No. 11

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OFFICE OF PETITIONS

In re Application of
Ajay Kumar Luthra et al
Application No. 09/587,875
Filed: June 6, 2000
Attorney Docket No. 16230-4923

DECISION ON PETITION

This is a decision on the petition to revive the above-identified abandoned application under 37 CFR 1.137(a),¹ or, alternatively under 37 CFR 1.137(b),² filed July 31, 2002.

The petition under 37 CFR 1.137(a) is **DISMISSED**.
The petition under 37 CFR 1.137(b) is **GRANTED**.

¹A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

²Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

BACKGROUND

The above-identified application became abandoned for failure to file a timely and proper reply to the Restriction Requirement (non-Final Office Action) mailed July 9, 2001. This Office action set a shortened statutory period for reply of one (1) month from the mailing date of the action. No proper reply having been received and no extensions of time obtained, the application became abandoned on August 10, 2001. Accordingly, a Notice of Abandonment was mailed May 22, 2002.

Petitioner asserts that "the recitation of claims in the Action bore no relation to the claims in the case", that he "believed that the Action was sent in error, that the Action was intended for another application." Petitioner asserts that he immediately called the Examiner and that the Examiner informed him that "he would correct the problem and get back to him". Thus, Petitioner argues that the delay in filing a proper response to the non-Final Office Action was unavoidable.

DISCUSSION

PETITION UNDER 37 CFR 1.137(a)

The petition lacks the required showing of unavoidable delay under 37 CFR 1.137(a). Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.⁴ A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant

³In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

of any deficiency in sufficient time to permit the applicant to take corrective action.⁵

Pursuant to 35 U.S.C. 133, the maximum statutory period for reply to an Office action is 6 months. Implementing regulation 37 C.F.R. 1.135 provides that if no reply is filed within the time set in the Office action under 37 CFR 1.134, or as it may be extended under 37 CFR 1.136, the application will be abandoned. Unless an Office action indicates that another consequence, such as disclaimer, will take place. 37 CFR 1.135 further specifies that an application becomes abandoned if applicant "fails to reply" to an Office action within the fixed statutory period either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e., failure to file a "complete and proper reply, as the condition of the case may require" within the statutory period.

Petitioner's reliance upon the Examiner to "correct the problem" was a judgment call of the petitioner and not the fault of the Agency. Furthermore, pursuant to 37 CFR 1.2 all business with the Patent and Trademark Office should be transacted in writing. The application became abandoned because instead of filing a timely written response to the office action, petitioner disregarded the regulations found at 37 C.F.R. 1.134, 37 CFR 1.135 and 37 CFR 1.136 in favor of the Examiner correcting a problem and getting back to him. It is the applicant's responsibility to take the necessary action in an application under a non-Final Office action to provide a complete and proper reply.

As petitioner has not provided a showing of evidence to satisfy the requirements of a grantable petition under 37 CFR 1.137(a), the petition will be dismissed.

PETITION UNDER 37 CFR 1.137(b)

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)).

The petition fee of \$1,280.00 for a petition under 37 CFR 1.137(b) will be charged to counsel's deposit account, No. 20-0823.

The requirements for revival under 37 CFR 1.137(b) having been met, this petition will be granted.

This application file is being forwarded to Technology Center 1713 for a review of the election filed July 31, 2002 in response to the restriction requirement mailed July 9, 2001.

Telephone inquiries related to this decision may be directed to the undersigned Petitions Attorney at (703) 305-4497.


Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

⁵See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also *In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994)(while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).